

REMARKS

Favorable reconsideration and allowance of the subject application are respectfully requested. Claims 1, and 3-20 are pending in the present application, with claims 1, 10, 11, and 18-20 being independent.

Allowable Subject Matter

Applicants note with appreciation the Examiner's indication on page 15 of the outstanding Office Action that claims 19-20 are allowed. Additionally, Applicants also appreciate the Examiner's indication on page 17 of the Office Action that claims 7-8 would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims. For at least the reasons detailed below, all pending claims should be considered allowable.

Claim Rejections Under 35 U.S.C. §103

The Examiner rejected: claims 1, 3, 6, 11-13, and 16 under 35 U.S.C. §103(a) as being unpatentable over Hiyama et al. (US 6,269,379) in view of Abecassis (US 6,504,990); claims 4-5, 9-10, 14-15, and 17-18 under 35 U.S.C. §103(a) as being unpatentable over Hiyama et al. in view of Abecassis and further in view of

Vaithilingam et al. (US 6,411,724). These rejections are respectfully traversed insofar as they pertain to the presently pending claims.

As previously submitted, Hiyama et al. is directed to a medical image filing system for enabling registration and retrieval of a plurality of medical images. Abecassis is directed to a method and system capable of playing a portion of a video segment of a video. In other words, the system of Abecassis processes, random accesses, buffers, and plays the video utilizing segment information.

Independent claims 1 and 11

The Examiner acknowledges on page 3 of the Office Action that Hiyama does not teach, with regards to independent claims 1 and 11:

the system including a moving picture;
various types of users and various types of user
terminals; and
wherein each of the user terminals has a processing
capability according to the type of user terminal, and
wherein the delivery condition specifies the processing
capability of each user terminal.

The Examiner, however, relies on Abecassis for support thereof. Specifically, the Examiner alleges that Abecassis teaches a delivery condition that specifies the processing capability of each user terminal and cites column 14, line 65 through column 15, line 11; column 62, lines 21-27; and column 78, lines 22-35 of Abecassis.

Applicants respectfully submit that the Examiner failed to establish a prima facie case of obviousness. To establish a prima facie case of obviousness, three basic criteria must be met: (1) there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art to modify the reference or to combine reference teachings; (2) there must be a reasonable expectation of success; and (3) the prior art reference must teach or suggest all the claim limitations, see *In re Vaack*, 947 F.2d 48, 20 USPQ2d 1438 (Fed.Cir.1991).

As stated above, the Examiner alleges that Abecassis teaches a delivery condition that supposedly specifies a processing capability of each user terminal and alleges that in combination with Hiyama, that this combination supposedly teaches a contents additional service means that edits and processes a retrieval result according to a delivery condition obtained from one of various types of user terminals in order to deliver the retrieval result. This allegation, however, is an improper legal conclusion.

First, Applicants once again note that Hiyama et al. provides absolutely no teaching that various/different types of conference units, e.g., user terminals, are connected to the network. Therefore, there is absolutely no motivation to combine Hiyama et

al. with Abecassis. In other words, the cited references do not contain any motivation to combine.

An essential evidentiary component of an obviousness rejection is a teaching or suggestion or motivation to combine the prior art references, see *C.R. Bard, Inc. v. M3 Systems, Inc.*, 48 USPQ2d 1225 (Fed. Cir. 1998). Combining prior art references without evidence of a suggestion, teaching or motivation simply takes the inventors' disclosure as a blueprint for piecing together the prior art to defeat patentability - the essence of hindsight, see *Interconnect Planning Corp. v. Feil*, 227 USPQ 543 (Fed. Cir. 1985). Evidence of a suggestion, teaching or motivation to combine may flow from the prior art references themselves, the knowledge of one of ordinary skill in the art, or in some cases, from the nature of the problem solved, see *In re Dembiczak*, 50 SPQ2d 1614 (Fed. Cir. 1999). However, a rejection cannot be predicated on the mere identification of individual components of the claimed limitations, see *In re Kotzab*, 55 USPQ2d 1313 (Fed. Cir. 2000). Rather, particular findings must be made as to the reason the skilled artisan, with no knowledge of the claimed invention would have selected these components for combination in the manner claimed, *Id.*

Applicants respectfully submit that the Examiner has used

nothing more than hindsight in order to combine Hiyama et al. and Abecassis, and has identified nothing in either publication that could be construed as a suggestion, teaching or motivation to combine the prior art references. Thus, the Examiner's reference combination is improper and should be withdrawn.

The Examiner incorrectly alleges on page 4 of the Office Action that:

it would have been obvious to a person having ordinary skill in the art at the time the invention was made to have modified Hiyama et al. by the teachings of Abecassis because the system including a moving picture would enable the system to capture (store), retrieve, edit and process moving images from a video unit as well as still images; and because various types of users and various types of user terminals [sic]; and wherein each of the user terminals has a processing capability according to the type of user terminal, would allow the image or the streaming data to be formatted according to the resolution and other formatting properties supported by the various devices/terminals used by different users.

This alleged statement, however, is not a proper reasoning nor does it substantiate an obviousness rejection.

"In order to rely on a reference as a basis for rejection of an applicant's invention, the reference must either be in the field of applicant's endeavor or, if not, then be reasonably pertinent to the particular problem with which the inventor was concerned." see *In re Oetiker*, 24 USPQ2d 1443, 1445 (Fed. Cir. 1992). Furthermore, MPEP 2141.01(a) states that PTO classification is some evidence of

"nonanalogy" or "analogy". See, for example, Wang Laboratories, Inc. v. Toshiba Corp., 993 F.2d 858, 26 USPQ2d 1767 (Fed. Cir. 1993) (Patent claims were directed to single in-line memory modules (SIMMs) for installation on a printed circuit motherboard for use in personal computers. Reference to a SIMM for an industrial controller was not necessarily in the same field of endeavor as the claimed subject matter merely because it related to memories. Reference was found to be in a different field of endeavor because it involved memory circuits in which modules of varying sizes may be added or replaced, whereas the claimed invention involved compact modular memories).

Hiyama et al. has a U.S. and International classification of 707/104 and G06F 17/30, respectively. Abecassis has a U.S. and International classification of 386/46 and H04N 5/92, respectively. Therefore, because Abecassis not in the field of Applicants' endeavor nor is it reasonably pertinent to the particular problem with which the inventor was concerned, one skilled in the art would not look towards Abecassis to make up for the deficiencies of Hiyama et al., which as acknowledged by the Examiner, is to teach the feature of "a system including a moving picture, various types of users and various types of user terminals; and wherein each of the user terminals has a processing capability according to the

type of user terminal, and wherein the delivery condition specifies the processing capability of each user terminal."

As such, because there is no suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art to modify the reference or to combine reference teachings, the Examiner has again failed to discharge his burden in establishing a prima facie case of obviousness.

Independent claims 10 and 18

Regarding independent claims 10 and 18, the arguments provided above with respect to independent claims 1 and 11 are further included with respect to independent claims 10 and 18, e.g. that because there is no suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art to modify the reference or to combine reference teachings, that the Examiner failed to establish a prima facie case of obviousness. In other words, there is absolutely no motivation to combine Hiyama et al. with Abecassis, as discussed above, and further with Vaithilingam et al.

Applicants also respectfully submit that the cited art, either alone or in combination, fails to teach or suggest that the feature

descriptor(s), which relate to a retrieval result, is transmitted to a user terminal prior to the retrieval result, and in the case that the retrieval result is to be received that the retrieval result is transmitted in response to a transmission request, as recited in independent claims 10 and 18.

The Examiner, however, alleges on page 10 of the Office Action that this is supposedly taught by Hiyama et al. in col. 4, lines 20-67. Referring to that cited section of Hiyama et al. it is taught that a view image is provided from, for example, an electronic endoscope, and that when an operator determines that the view image should be stored, the view image is then provided to the image processor for processing and storage. This view image, however, is not provided onto the LAN 4a, 5a and is then provided to the conference units 6. The view image of Hiyama et al. is only provided to the image processor 12 for processing, e.g., management information is added to the view image in order to create an image file, see col. 4 lines 44-45.

In contrast thereto, the user terminal of the present invention, according to a preferred embodiment, provides a retrieval result that satisfies a retrieval condition in order to retrieve a feature descriptor. Then a feature descriptor relating to the retrieval result is transmitted to the user terminal prior

to the retrieval result being transmitted. If the user terminal decides to determine that the retrieval result is to be received, on the basis of an analysis of the feature descriptor by the user terminal, a transmission request is provided in order to receive the retrieval result. As such, it should now be evident that the cited art does not teach all of the claim limitations.

Dependent claims 2-9 and 12-17 should be considered allowable at least for depending from an allowable base claim.

Accordingly, in view of the above discussion, Applicants respectfully request that the Examiner withdraw each of the rejections.

Lastly, claims 5, 19, and 20 have been amended. This amendment does not narrow the scope of the claims, nor does it add any new subject matter.

Conclusion

In view of the above amendments and remarks, this application appears to be in condition for allowance and the Examiner is, therefore, requested to reexamine the application and pass the claims to issue.

Should there be any outstanding matters that need to be resolved in the present application, the Examiner is respectfully

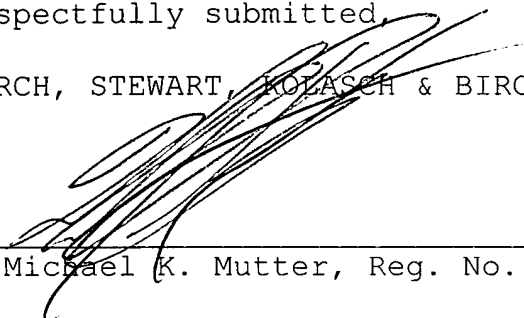
requested to contact Martin Geissler (Reg. 51,011) at telephone number (703) 205-8000, which is located in the Washington, DC area.


If necessary, the Commissioner is hereby authorized in this, concurrent, and future replies, to charge payment or credit any overpayment to Deposit Account No. 02-2448 for any additional fees required under 37 C.F.R. §§ 1.16 or 1.17; particularly, extension of time fees.

Respectfully submitted,

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